

REMARKS/ARGUMENTS

As amended above, claims 1-3 and 6 are pending in the instant application. In the most recent Office Action, claims 1-6 were rejected under 35 U.S.C. §103(a) as allegedly obvious over DE 3609984 (hereinafter, "Haghiri") in view of U.S. Patent Application Publication 2004/0237977 by Nandram et al. (hereinafter, "Nandram"). Applicant respectfully traverses the rejection for at least the following reasons.

As amended above, claim 1 incorporates subject matter previously recited in claim 5. Specifically, claim 1, as amended, recites, a cigarette comprising, *inter alia*, a tubular wrapper of smokable material having at least three tear lines, a third tear line provided in the tubular wrapper in a region of a second end of the tobacco element so as to facilitate tearing of the tubular wrapper and removal of the second filter element. The Office Action avers that it would have been obvious to add a third tear line to the Haghiri reference in order to enable a user to choose which filter to detach from the smoking article. Applicant respectfully disagrees.

Haghiri shows in Figure 4 a tear line (7) adjacent to one of two filters. The Office Action speculates that adding a third tear line adjacent the opposite filter would enable the user to choose which filter to detach. However, within the teachings of Haghiri it would be redundant to provide such second tear line, as there is no need to choose which filter to detach in order to use the full tobacco length of the cigarette.

In fact, the only teaching of detaching both filters comes by way of the present specification. Applicant's specification teaches at paragraph [0018], as an illustrative example only, that the additional tear line adjacent the second filter allows the smoker the option of smoking unfiltered cigarettes if he or she so desires.

In the absence of a teaching or suggestion in the prior art to modify the reference as

proposed by the Office Action, it is only through improper hindsight reconstruction that the Office Action arrives at the present claims. This is, of course, impermissible. To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 312-313 (Fed. Cir. 1983).

The remaining cited references fail to offer any teaching or suggestion to ameliorate the deficiency of Haghiri with respect to independent claim 1. It is well settled by the courts that, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Because the cited references taken singly or in any combination fail to teach or suggest all features of the recited claims as illustrated above, applicant respectfully submits that the rejections have been obviated. Favorable reconsideration and withdrawal is kindly solicited.

Method claim 6 is also amended above to incorporate commensurate limitations previously recited in dependent claim 5. For at least the same reasons, applicant respectfully submits that claim 6 is similarly patentably distinguished over the prior art of record. Favorable reconsideration and withdrawal of the rejection is kindly solicited. With respect to dependent claims 2 and 3, these claims are separately patentable. However, they are submitted as patentable for at least the same reasons as their underlying independent base claim 1.

In light of the foregoing, applicant respectfully submits that all claims recite patentable subject matter and kindly solicits an early and favorable indication of allowability of all pending claims. In the interest of brevity, Applicant has addressed only so much of the rejection as is

considered sufficient to demonstrate the patentability of the claims. Applicant's failure to address any part of the rejection should not be construed as acquiescence in the propriety of such portions not addressed. Applicant maintains that the claims are patentable for reasons other than these specifically discussed, *supra*.

If the Examiner has any reservation in allowing the claims and believes that a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

THIS CORRESPONDENCE IS BEING
SUBMITTED ELECTRONICALLY
THROUGH THE PATENT AND
TRADEMARK OFFICE EFS FILING SYSTEM
ON September 18, 2006.

DJT:lf

Respectfully submitted,



David J. Torrente
Registration No.: 49,099
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700